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First Named Inventor

R. Mark Halligan

Art Unit

3623

Examiner Name

Boyce, A.

Attorney Docket Number

7208-90742

ENCLOSURES (Check all that apply)

☐ Fee Transmittal Form

☐ Fee Attached

☐ Amendment/Reply

☐ After Final

☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☐ Response to Missing Parts/
Incomplete Application

☐ Response to Missing Parts
under 37 CFR 1.52 or 1.53

☐ Drawing(s)

☐ Licensing-related Papers

☐ Petition

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Provisional Application

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-Postcard

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Welsh & Katz, Ltd.

Signature

Printed name

Jon P. Christensen

Date

February 14, 2007

Reg. No.

34,137

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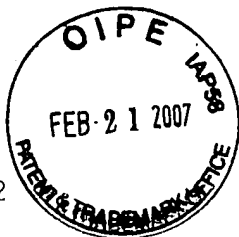
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90742

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: R. Mark Halligan Art Unit: 3623
Serial No.: 10/701,889
Filed: November 5, 2003
For: METHOD AND APPARATUS FOR THE DISCOVERY
OF TRADE SECRETS INCLUDING THE COLLECTION,
COMPILATION, CORRELATION, INTEGRATION,
CATEGORIZATION, AND REPORTING OF DATA
ABOUT TRADE SECRETS
Examiner: Boyce, A.
Attorney
Docket No.: 90742

REPLY BRIEF

Mail Stop: Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Examiner's Answer of January 19, 2007,
applicant responds as follows:

In the Examiner's Answer, the Examiner glosses over a
multitude of differences between Applicant's invention and the
subject matter taught by Katz et al. and Jacobsen et al. At least
some of these differences may be described as follows.

1) Katz et al. and Jacobson et al. are both directed to methods
of searching databases using queries. Such acts of searching do
not change the contents of the database, which is why Applicant
described these databases as "static" in the appeal brief, to which

description Examiner objected in the response to Applicant's appeal brief. The databases are indeed not eternally static -- the databases involved surely change over time -- but Applicant's point in the appeal brief was that the databases are unchanged by the act of searching (the primary objective of the method in Katz et al.) and by the act of clustering documents in the search query response (the primary objective of the method in Jacobson et al.) In contrast, Applicant's invention is not directed to searching or processing search results, but to a method of processing that changes the database itself.

The claimed method of processing that changes the database itself is the core of Applicant's claimed invention (e.g. claim 1): "using mathematical and logical formulae to eliminate any redundancy among the sets of descriptive information about potential trade secrets to define a collection of descriptive information about potential trade secrets of the organization." First, this method "eliminate[s] any redundancy" in the database, differentiating it from the method of Jacobson et al., which clusters documents in the search query response only and not in the entire database.

Moreover, the clustering in Jacobson is dependent on the nature of the search query itself. For example, under Jacobsen, "The present invention provides for clustering the documents matching the query keywords based on the occurrence of terms in the vicinity of query keywords..." (Jacobson et al., col. 2, lines 46-

49). If a user provides a different search query to the Jacobson et al. method, then the Jacobson et al. documents will be clustered differently. In contrast, Applicant's method is not driven by a search query, and the results of the claimed method are thus independent of any search query. Under Applicant's invention, the processing is dependent solely on the contents of the database entries themselves, without any regard for any outside information such as a search query.

Further, Applicant's invention functions (e.g. claim 1): "to define a collection of descriptive information about potential trade secrets of the organization." That is, it modifies the database, or creates a new database, that does not contain the redundancy, which has been eliminated. Neither Katz et al. nor Jacobson et al. describes or teaches any method that acts to change the database itself, either through modification or replacement. Neither Katz et al. nor Jacobson et al. describes or teaches any method that is independent of a search query provided by the user.

Finally, by producing and processing search query results, both Katz et al. and Jacobson et al. provide the output of their methods to the single user who initiated the search query. Applicant's invention, by changing the database itself, modifies the results seen by all users of the database. That is, the methods of Katz et al. and Jacobson et al. are directed toward providing tailored search query results to the individual user, while Applicant's method is directed toward providing a non-

redundant list of trade secrets that is the same for each and every user of the system.

2) Katz et al. is directed to a method of searching multiple databases of intellectual capital distributed across multiple computers, with each entry remaining on the computer of the individual user who entered the information. This is explicit from the abstract -- "Entries in the database are stored on individual computers." -- and runs through the entire specification and claims. Katz et al. does not anticipate, describe, teach or even suggest the steps of the Applicant's invention, and in fact runs counter to Applicant's method as described in the specification and particularly in the claim language (e.g. claim 1): "collecting sets of descriptive information about potential trade secrets through an input device of a computer from a plurality of persons of the organization into a database of the computer."

Similarly, Jacobson et al. is directed to searching "a universe of documents" (Jacobson et al. col. 2, lines 4-6). It is to be presumed that such a "universe" resides on more than one computer. In any case, Jacobson et al. does not limit its claims to searching and clustering documents that reside in a single database or on a single computer. Jacobson et al. does not anticipate, describe, teach or even suggest the steps of the Applicant's invention, and in fact runs counter to Applicant's method as described in the specification and particularly in the

claim language: "collecting sets of descriptive information about potential trade secrets through an input device of a computer from a plurality of persons of the organization into a database of the computer."

3) In his finding, Examiner relies on the mention of trade secrets in Katz et al. to assert that "Katz et al. disclose a method of discovering trade secrets of an organization..." In fact, the term "trade secret" occurs in Katz et al. exactly once in the specification -- and not at all in the claims -- in a laundry list of items that may constitute "intellectual capital". In contrast, Applicant's invention focuses specifically and exclusively on trade secrets -- by definition, such information as qualifies for legal protection as trade secret property under federal, state, and common law. In consequence, the term "trade secret" appears 335 times in the title, abstract and specification of Applicant's invention, and further appears at least once in every single one of the claims.

While Katz et al. is directed to a method involving intellectual capital, which may or may not be trade secrets, Applicant's invention is directed to a method involving trade secrets, which may or may not be intellectual capital. The difference is not subtle. The two categories overlap, but there are trade secrets that do not qualify as intellectual capital (e.g.: quarterly sales figures, customer sales data), and

intellectual capital that does not qualify as trade secrets (e.g.: patents, information that has been published or disclosed). Thus, the two are not the same, any more than "mammals" and "animals with brown eyes" are the same.

Indeed, much of Katz et al. is directed to patents: "Third, companies do not have a simple and convenient way to license patents. Companies with extensive patent portfolios will often grant blanket licenses to their portfolios to simplify the transaction. Fourth, smaller companies don't have an easy time soliciting licensees." (Katz et al., paragraph 3) Applicant's method applies strictly to trade secrets and is inappropriate for use in inventorying patents.

4) Katz et al. does not "disclose correlating among the sets of descriptive information about potential trade secrets" in paragraph 50, as Examiner asserts in disallowing Applicant's claim 2. Katz et al. paragraph 50 describes searching the database "by many different criteria" as well as "by any combination of these criteria." Such simple searches are not the same as or anything like the extensive correlation action of Applicant's invention as described in the specification on pages 21 through 24.

5) With regard to the elimination of redundancy, Examiner asserts in the response to Applicant's appeal brief that "Appellant's specification does not seem to even mention eliminating any

redundancy among sets of descriptive information, much less that the elimination of redundancy equates to getting rid of or removing that which exceeds what is normal or necessary, as is now alleged for the first time in Appellant's Appeal Brief." In fact, Examiner's response to Appellant's appeal brief is the first time that Examiner has failed to find justification in the specification for the "eliminates any redundancy" portion of the claim language. In previous office actions, Examiner has instead argued that clustering of documents was equivalent to eliminating redundancy, not that elimination of redundancy was unsupported by the specification.

The specification does, in fact, contains support for the elimination of redundancy in multiple locations: On page 5: "The traditional trade secret audit continues with the compilation of the interview data into lists of the potential trade secrets through the correlation of references to the same trade secret from multiple interviewees and integration of data relating to the same trade secret from multiple interviewees into a single entry. This process is traditionally manually performed by trade secret auditors in a subjective manner from their interview notes. One of the inventions we claim is a system to perform compilation of the interview data into lists of the potential trade secrets through a process of correlation and integration in an objective manner by automated means..." (Specification, page 5, line 25 to page 6, line 3).

Again on page 10: "The current invention collects potentially redundant data from multiple individuals and condenses this data into non-redundant potential trade secrets" (Specification, page 10, lines 6-8).

Again on page 11: "The system includes a method and apparatus for analyzing multiple redundant entries from a plurality of persons to result in a non-redundant list of potential trade secrets..." (Specification, page 11, lines 17-19).

Again on page 12: "Correlating the entered information across multiple potential trade secrets to find the multiple redundant entries that correspond to non-redundant trade secrets" and "Integrating the redundant potential trade secrets into a single entry for each of the non-redundant potential trade secrets into which they have been correlated" (Specification, page 12, lines 13-18).

This correlation and integration process is described on pages 21 through 24 of the specification, including the key recognition: "Each subdivision created in this process constitutes one non-redundant trade secret."

Each of these references in the specification relates to the processing of multiple redundant entries to result in a single non-redundant entry, thus eliminating the redundancy.

With respect to Examiner's assertion, "that the elimination of redundancy equates to getting rid of or removing that which exceeds what is normal or necessary ... is now alleged for the first time in

Appellant's Appeal Brief," Applicant disagrees. The correct formulation is not "equates to", but should be "is defined as". The dictionary is included under law as a part of legal documents. Absent a superseding definition in the document or under law, the definitions of words in legal documents are to be provided by the dictionary. Thus resorting to the dictionary for the definitions of words is not an allegation. The meaning is inherent in the words, and was so from Applicant's first filing.

Further, it is clear that Examiner's proposal of the secondary meaning of "eliminate" as "to set aside as unimportant," or "ignore" cannot be supported in the context of the specification as noted above. The redundancy is not ignored, nor are the redundant entries ignored. The redundant entries are processed to produce a new entry. Were the redundancy ignored or set aside as unimportant, no processing would be necessary.

Neither does Jacobson et al. ignore or set aside as unimportant the documents contained in the clusters produced in response to search queries. Examiner asserts that "Jacobsen et al. discloses one document representing all the documents, thus setting aside or ignoring the other documents." In fact, Jacobson et al. describes this as the methodology of prior art, and distinguishes his method from Examiner's formulation. In this regard, Jacobson et al. states that "The aim of traditional document clustering techniques has been to identify document-clusters such that any document in the cluster is representative of the set of all

documents in the cluster. Consequently, these traditional techniques focus only on the similarity between pairs of documents in determining document clusters and do not take the query into account. The clustering algorithm of the present invention, however, differs significantly from traditional document clustering techniques, since the document clusters created have the property that the set of all documents in the cluster considered together is a better answer to the query than any single document in the cluster" (Jacobson et al., col. 5, line 60 to col. 6, line 4). Thus Jacobson et al. does not ignore or set aside as unimportant the other documents in the cluster as Examiner asserts, further distancing Jacobson et al. from the "elimination of redundancy" of Applicant's invention. Indeed, Jacobsen et al. asserts the importance of all the documents in the cluster.

Applicant therefore argues that Applicant's invention is not rendered obvious by Katz et al. and Jacobson et al., but rather the reverse. A reading of Katz et al. and Jacobson et al. by one skilled in the art would actually lead the reader away from Applicant's invention. Katz et al. and Jacobson et al., taken together, would lead one to consider:

- 1) a system in which user-driven search queries were used to select subsets of the database for processing as in both Katz et al. and Jacobson et al., rather than processing over the whole database as in Applicant's invention;

- 2) a system in which the results depended on the contents of

the search query itself as in both Katz et al. and Jacobson et al., rather than depending solely on the nature of the entries in the database.

3) a system in which the database was unchanged by the methods involved in the system, such methods being applied only to the search query results, as in both Katz et al. and Jacobson et al., rather than providing a method that processes the database itself and results in changes to the database as in Applicant's invention;

4) a system in which the results are tailored to individual user needs in response to search queries as in Katz et al. and Jacobson et al., rather than providing a method that processes the database independently of user search query input and provides the same results to all users of the system.

5) a system in which entries for trade secrets were left distributed on multiple computers as in both Katz et al. and Jacobson et al., rather than being collected into a single database on one computer as in Applicant's invention;

6) a system in which trade secrets, patents, and other intellectual capital were all processed in the same manner as in Katz et al., rather than providing a special method applicable to trade secrets only as in Applicant's invention;

7) a system in which trade secrets that did not fit into the description of intellectual capital, such as sales figures and customer data, would not be processed by the system as in Katz et al., rather than providing a method that encompasses all trade

secrets as in Applicant's system;

8) a system in which user-driven search criteria were the sole method of a simplistic correlation as in Katz et al., rather than provide complex, automated correlation features as in Applicant's invention; and

9) a system in which similar entries in response to a search query were clustered as in Jacobson et al., rather than truly redundant entries throughout the database being identified and integrated into non-redundant entries as in Applicant's invention.

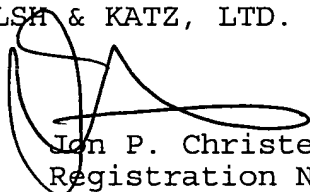
Such systems may be useful. Such systems may even be obvious under Katz et al. and Jacobson et al. But Applicant's system is not such a system, and is not rendered obvious by Katz et al. and Jacobson et al.

For the foregoing reasons, allowance of claims 1-52, as now presented, is believed to be in order. It is respectfully requested that this Board reverse the decision of the Examiner in all respects.

Respectfully submitted,

WELSH & KATZ, LTD.

By


Jon P. Christensen
Registration No. 34,137

February 14, 2007
WELSH & KATZ, LTD.
120 South Riverside Plaza
22nd Floor
Chicago, Illinois 60606
(312) 655-1500